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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,219	01/30/2004	Kin Yip Wan	08364.0073	2586

7590 01/11/2005  
Finnegan, Henderson, Farabow,  
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1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER
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LEE, Y MY QUACH

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/767,219	WAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Y Quach Lee	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “602a” has been used to designate both “an aperture of an upper sole” as shown in drawing figure 6 and “depressable portion of an inner sole” as shown in drawing figure 8.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) “701” as mentioned on line 18 of page 7, “15” (shown in phantom lines) as mentioned on lines 31 to 32 of page 7, “607” as mentioned on line 27 of page 11, and “1002” as mentioned on line 14 of page 15 in the description.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of “on or more portions of light affecting means on a wall of the chamber” as claimed in claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because the abstract is not on a separate sheet of paper. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: Page 12, line 26, the reference numeral "602" is incorrect and should be changed to --602i-- in view of drawing figures 8 and 10. Page 15, line 20, the reference numeral "1001g" is incorrect and should be changed to --1002g-- in view of drawing figure 11 and "filaments 1002g" on lines 31 and 33 of the same page. Appropriate correction is required.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. For instance, there is no antecedent support for the control means as claimed in claim 7 (for controlling the motive means as set forth in previous claim) operable to receive information defining an image as presented in the original description of the specification. Correction is required. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

### *Claim Objections*

8. Claim 6 is objected to because of the following informalities: In claim 6, there is no clear antecedent basis for "the motive means". Appropriate correction is required.

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9. Regarding claims 1 to 11, the phrase "such as" renders the claims improper and confusing. It is suggested that this phrase "such as a shoe" should be deleted since the limitation "a shoe" is not part of the claim and is not positively recited in the claims.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 to 5, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Perry et al.

Perry et al. show an article of apparel (82) carrying a chamber (figures 2, 6, 8) and illumination means (LED, column 6, line 58) for illuminating the chamber with light, the chamber having light affecting means (52, column 5, lines 29 to 30, column 6, lines 51 to 55 and 62 to 64) adapted to affect light from the illumination means, the chamber having a window (opening of the chamber) for enabling the effect of the light affecting means on light from the illumination means to be viewed, a motive means (58, motor, column 3, 22 to 24) for moving the light affecting means in response to movement of at least a part of a wearer (column 7, lines 38 to 39) of the article, and illumination control means or activating means (column 7, lines 36 to 39) for controlling or activating the illumination means so that the illumination means and the light affecting means produce a projected image (4a, column 3, lines 14 to 17, column 5, 26 to 28).

12. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Perry et al.

Perry et al. show an article of apparel (82) carrying a chamber (figures 2, 6, 8) and illumination means (column 3, lines 40 to 41, column 6, line 58) for illuminating the chamber with light, the chamber having light affecting means (52, column 5, lines 29 to 30, column 6, lines 51 to 55 and 62 to 64) adapted to affect light from the illumination means, the chamber

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having a window (opening of the chamber) for enabling the effect of the light affecting means on light from the illumination means to be viewed, and a control means (column 7, lines 36 to 39) for controlling a motive means (58, motor, column 3, 22 to 24) and operable to receive information defining an image (4a, ...) so that the illumination means and the light affecting means produce a projected image (4a, column 3, lines 14 to 17, column 5, 26 to 28).

13. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Perry et al.

Perry et al. show a chamber (figures 2, 6, 8) for attachment to an article of apparel (82) illuminable with light, the chamber containing light affecting means (52, column 5, lines 29 to 30, column 6, lines 51 to 55 and 62 to 64) adapted to affect light from an illumination means (column 3, lines 40 to 41, column 6, line 58), and the chamber having a window (opening of the chamber) for enabling the effect of the light affecting means on light from the illumination means to be viewed.

14. Claims 1 to 5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Waits.

Waits shows an article of apparel (10) carrying a chamber (30) and illumination means (44) for illuminating the chamber with light, the chamber having light affecting means (58a, 58b, 58c) adapted to affect light from the illumination means, the chamber having a window (36) for enabling the effect of the light affecting means on light from the illumination means to be viewed, the light affecting means is movable or rotatable (column 3, lines 45 to 51 and 55 to 60) within the chamber, a motive means (52, or motor) for moving the light affecting means in response to movement of at least a part of a wearer (selected by a user through the movement of the user's fingers) of the article, and illumination control means or activating means (28) for controlling or activating the illumination means so that the illumination control means and the light affecting means produce a projected image (projected light beam).

15. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Waits.

Waits shows an article of apparel (10) carrying a chamber (30) and illumination means (44) for illuminating the chamber with light, the chamber having light affecting means (58a, 58b, 58c) adapted to affect light from the illumination means, the chamber having a window (36) for enabling the effect of the light affecting means on light from the illumination means to be viewed, and a control means (column 3, lines 49 to 52) for controlling a motive means (52 or

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motor) so that the illumination means and the light affecting means produce a projected image (projected light path).

16. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Waits.

Waits shows a chamber (30) for attachment to an article of apparel (10) illuminable with light, the chamber containing light affecting means (58a, 58b, 58c) adapted to affect light from an illumination means (44), and the chamber having a window (36) for enabling the effect of the light affecting means on light from the illumination means to be viewed.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al.

Perry et al. disclose the invention substantially as claimed with the exception of having one or more portions of light affecting material on a wall of the chamber.

The orientation of the elements such as one or more portions of the light affecting means on the wall of the chamber would have been an obvious matter of design choice which provides no unusual, unobvious and or unexpected result and is therefore deemed to fall within a purview of ordinary engineering design technique to arrange one or more portions of light affecting means on the wall of the chamber or any suitable location within the chamber so that the image can be directed and projected in a desirable manner to suit different applications or individual.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malm and Norton are cited to show other pertinent article of apparels carrying light affecting means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is 703-308-2733.

Y. Q.  
January 6, 2005



Y Quach Lee  
Patent Examiner  
Art Unit 2875